



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/490,362	01/24/2000	Steven M. Golden	2166	7063

7590 04/21/2003

Michael P. Mazza
Niro, Scavone, Haller & Niro
181 W. Madison
Suite 4600
Chicago, IL 60602

EXAMINER

ALVAREZ, RAQUEL

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 04/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/490,362	GOLDEN ET AL.
	Examiner Raquel Alvarez	Art Unit 3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 1/28/03.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 20-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 20-60 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

1. This action is in response to communication filed on 1/28/2003. Claims 20-60 are presented for examination.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 20-60 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 5,761,648. Although the conflicting claims are not identical, they are not patentably distinct from each other because both are claiming common subject matter as follows: establishing electrical communication between a service system and a plurality of remote users; receiving profile data at the service system input by the remote users; transmitting redeemable coupons to the remote users.

3. Claims 20-60 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-16 of copending Application No. 09/484,290. This is a

provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: establishing a communication between a service system and a plurality of remote users; receiving profile data at the service system from the remote users; issuing offers for electronic certificates to the remote users, the electronic certificate offers being limited to selected remote users on the basis of the profile data; receiving at the service system inputs indicative of remote users selections; assigning identification data to each electronic certificate.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 20-32, 34, 36-42 and 44-60 are rejected under 35 U.S.C. 102(e) as being anticipated by Barnett et al. (6,336,099 hereinafter Barnett).

With respect to claims 20-29, 32, 36-41, 49-51, 53-56 and 58-60 Barnett teaches establishing electrical communication over the Internet between a service system plurality of remote users having personal computers (i.e. the online service provider 2 transmits product information to a response unit at a customer site)(Figures 1 and 9); receiving profile data at the service system input by the remote users over the Internet, the profile data being accessible at a time contemporaneous with its input by the remote users (i.e. the online service provider receives user data)(see figures 1 and 9); the service system conditioning issuance of redeemable coupons to remote users based upon entry of profile data requested of the remote users by the service system (see figure 1); making accessible over the Internet to selective remote users selective offers for the redeemable coupons, selective offers being based on analysis of the profile data (see figures 1 and 9); inputting to the service system over the Internet selections by the remote users of the redeemable coupon offers, the selections comprising selection data and being accessible for analysis by the service system at a time contemporaneous with their input by the remote users (i.e. the user's requests are analyzed and sent to the coupon distributor)(figure 1); making accessible over the Internet to selective remote users further redeemable coupon offers, the further offers being limited to the selective remote users on the basis of the selection data (i.e. col. 7, lines 36-55).

With respect to claims 30 and 31, Barnett further teaches that the issuer system communicates directly with the service system using a shared computer network (see Figure 1).

With respect to claim 34, Barnett further teaches permitting the user to print the selected electronic certificates and redeeming the coupons by presenting them at the check-out (see Figure 1).

With respect to claim 42, Barnett further teaches that the coupons are revised by the service system in an interactive and instantaneous basis (see Figure 1).

Claims 44-46, 48 and 57 differ from claims 20, 49, 51, 55, 56 and 58 in that the claims further recite and Barnett further teaches receiving demographic data at the service station from the user and the certificates being issued according to the demographic data received (Figure 9).

With respect to claims 47 and 52, the limitations were previously addressed in the rejection to claim 21 and therefore rejected under similar rationale.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 33, 35 and 43 rejected under 35 U.S.C. 103(a) as being unpatentable over Barnett et al. (6,336,099 hereinafter Barnett).

Claims 33 and 35 further recite that the coupons selected are redeemed using a credit card. Official notice is taken that it is old and well known to identify the user of a coupon or a check by asking the user for an identification. For example, when a customer presents a check or a coupon the customer is asked to produce identification, this identification can be a credit card, a driver's license or the like. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included redeeming the coupons selected using a credit card for the above mentioned advantages.

Claim 43 further recites that the identification data comprises a combination of a remote user identification and a coupon identification code. Barnett teaches that the identification data comprises a coupon identification code (see figure 5). Barnett does not specifically teach that the identification data comprises a remote user identification. Official notice is taken that it is old and well known to include a user identification in order to assure the identity of the user, such as in a credit card, or the like. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included a combination of a remote user identification and a coupon identification code in order to assure that the coupon belongs to the identified user.

Response to Arguments

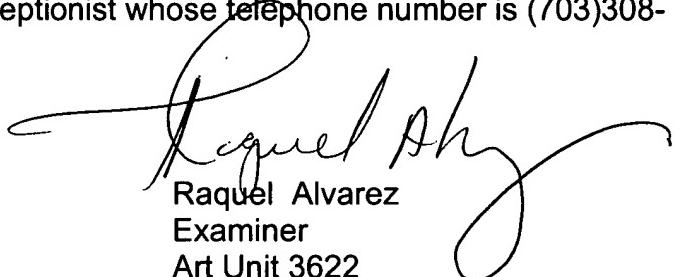
6. Applicant's arguments with respect to claim 20-60 have been considered but are moot in view of the new ground(s) of rejection.

Point of contact

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703)305-0456. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w Stamber can be reached on (703)305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9326 for regular communications and (703)872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.



Raquel Alvarez
Examiner
Art Unit 3622

R.A.
April 11, 2003